

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINGO C. TUASON JR., THOMAS A. RUSZKAY,
and SYDNEY HEESE

Appeal No. 1999-0675
Application No. 08/379,803

ON BRIEF

Before WARREN, TIMM, and JEFFREY SMITH, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1-13, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 134.

THE INVENTION

According to Appellants, the invention relates to a non-nutritive, fat-like agent for use in the preparation of low-calorie food compositions (specification at 1, ll. 4-5). Claim 1 is illustrative:

1. A composition comprising dry, water-dispersible particles, said particles consisting essentially of an agglomerate of components comprising microreticulated or microfibrillated microcrystalline cellulose in a predominant amount by weight, and a hydrocolloid selected from a [sic] the group consisting of carboxymethylcellulose and xanthan gum in an amount sufficient to provide effective coverage of the cellulose, which agglomerate readily disperses in water into its component parts under aqueous food-processing conditions.

THE EVIDENCE

As evidence of unpatentability, the Examiner relies upon the following prior art references:

McGinley et al. (McGinley)	5,192,569	Mar. 9, 1993 (filed Dec. 18, 1991)
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Concise Encyclopedia Chemistry 437 (Mary Eagleson trans., 1994)(Encyclopedia)

THE REJECTIONS

Claims 1-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McGinley and under the judicially-created doctrine of obviousness-type double patenting as unpatentable over claims 15 and 21 of McGinley in view of the Encyclopedia (Answer at 3-5). We reverse for the following reasons.

OPINION

Anticipation Rejection

The Examiner rejects all the claims as anticipated by McGinley. To anticipate, McGinley must disclose every limitation of the claimed invention, either explicitly or inherently. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). The Examiner agrees that McGinley does not explicitly disclose every limitation. However, the Examiner relies on a theory of inherency. In such a situation, the Examiner must provide a sound basis for believing that the claimed composition and that of McGinley are the same before the burden shifts to Appellants to show that they are indeed different. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *see also In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 432-33 (CCPA 1977)(the assertion of inherency must be reasonable). It must be remembered that the initial burden of establishing a *prima facie* case of unpatentability rests upon the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3; and *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The Examiner argues that the process described by McGinley is the same as Appellants' process and concludes that the product must then inherently share the same properties (Answer at 7). The problem is that this is not a case in which an identical starting material is subjected to the same or similar process techniques. *See Spada*, 911 F.2d at 708, 15 USPQ2d at 1657-58 (“[W]e think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada

of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition”). In the present case, all of the claims require the presence of microreticulated or microfibrillated microcrystalline cellulose (MRC or MFC) in a predominant amount by weight. The specification describes MRC and MFC as highly sheared forms of microcrystalline cellulose (MCC) prepared by subjecting MCC to certain defined shearing processes (specification at 1, l. 30 to 2, l. 4 and 3, l. 28 to 18). In contrast, McGinley describes either using plain unsheared MCC (McGinley at col. 2, ll. 53-64; col. 4, ll. 25-29, col. 4, ll. 39-42 and col. 4, ll. 57-68) or shearing MCC/galactomannan gum (MCC-GG) aggregate under “high energy shear conditions” (McGinley at col. 8, ll. 31-39). When high energy shear is applied, the result is a very fine, fibrous, GG-coated MCC particle in aggregate form (McGinley at col. 9, ll. 11-13). Even if we accept the fact that the “high energy shear” of McGinley is the same or similar to the shearing process used to make MRC and/or MFC, the starting material sheared is different. The Examiner provides no reasonable basis to believe that sheared MCC-GG in aggregate form is the same as MRC or MFC.

The Examiner has failed to establish anticipation with respect to the subject matter of claims 1-13.

Obviousness-type Double Patenting

The Examiner rejected claims 1-13 under the judicially-created doctrine of obviousness-type double patenting over claims 15 and 21 of McGinley. An obviousness-type double patenting analysis entails two steps: (1) determine the differences between the subject matter of

the pending and patented claims and (2) determine whether the differences render the claims patentably distinct. *Eli Lilly and Co. v. Barr Labs. Inc.*, 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001). Claims are not patentably distinct, and thus properly rejected for obviousness-type double patenting, when the subject matter of those claims is obvious over, or anticipated by, the subject matter of the patented claim. *Id.*

In the present case, there is a key difference between the subject matter of the pending and patented claims which is not addressed in the rejection. Neither patented claims 15 and 21, nor the claims they depend from, recite the inclusion of MRC or MFC in the particles of the composition. The Examiner has failed to address this difference. The rejection lacks the necessary findings of fact to establish that the claims are not patentably distinct. Therefore, the Examiner failed to establish a *prima facie* case of obviousness-type double patenting.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-13 under 35 U.S.C.
§ 102(e) and for obviousness-type double patenting is reversed.

REVERSED

CHARLES F. WARREN
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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